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In re Application of : DECISION ON PETITIONS  
SRIVASTAVA, et al. :  
Application No.: 09/485,877 :  
PUT No.: PCT/US99/13812 : UNDER 37 CFR 1.137(b)  
Int. Filing Date: 18 June 1999 :  
Priority Date: 19 June 1998 : AND 37 CFR 1.47(a)  
Attorney Docket No.: Srivas-14-21 :  
For: GAIN TILT CONTROL WITH MID- :  
STAGE ATTENUATORS IN ERBIUM- :  
DOPED FIBER AMPLIFIERS :  
:

**BACKGROUND**

On 18 June 1999, applicant filed the international application, which claimed a priority date of 19 June 1998. A Demand for international preliminary examination in which the United States was elected was not filed prior to the expiration of 19 months from the priority date. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 19 February 2000.

On 16 February 2000, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee, the \$130.00 surcharge for providing an oath or declaration later than 20 months from the priority date and an Information Disclosure Statement. An oath or declaration was not included.

On 03 April 2000, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration executed by all the inventors was required. The notification set a ONE (1) MONTH period for response. Extensions of time were available.

On 10 October 2000, applicant responded with the present petitions. A petition for revival under 37 CFR 1.137(b) and a petition under 37 CFR 1.41 which is being treated as a petition under 37 CFR 1.47(a). Accompanying the petition under 37 CFR 1.47(a) was a combined Declaration and Power of Attorney executed by inventors Atul Srivastava, James Sulhoff, Yan Sun, Charles Wolf and Jianhui Zhou. The combined Declaration and Power of Attorney was not executed by joint-inventor John Zyskind, the subject of the present petition

under 37 CFR 1.47(a).

## DISCUSSION

### **A. Petition to Revive Under 37 CFR 1.137(b)**

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

With regard to Item (1), the proper response was providing an oath or declaration. Applicant has provided a declaration executed by each of the named inventors with the exception of inventor John Zyskind. However, applicant has included a petition under 37 CFR 1.47(a) along with the present petition and authorized deduction of any fees which may be required. This is considered a proper reply for the purposes of the petition to revive under 37 CFR 1.137(b).

As to Item (2), applicant has authorized deduction of the \$1240.00 petition fee from Deposit Account 12-2325.

With regard to Item (3), applicant's statement that, "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

Applicant having complied with the above requirements, the petition under 37 CFR 1.137(b) to revive the application is **GRANTED**.

### **B. Petition Under 37 CFR 1.47(a)**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Items (1) and (3), applicant has deduction of the required petition fee of \$130.00 and the petition states the last known address of the non-signing inventor.

Regarding Item (4), accompanying the petition is a declaration signed by the remaining inventors on their behalf, and on behalf of the non-signing inventor. Accordingly, Items (1), (3) and (4) have been satisfied.

As to Item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal states that, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." Counsel has provided copies of two letters mailed to Mr. Zyskind by way of Express Mail asking Mr. Zyskind to execute enclosed "Assignment and Agreement" and "Declaration and Power of Attorney." However, there is no indication in the present petition or accompanying papers that applicant has made a bona fide attempt to present Mr. Zyskind with a copy of the application papers, including the specification, claims and drawings as required.

Accordingly, since applicant has failed to show that Mr. Zyskind was provided with a complete set of the application papers and refused to sign the application papers or that Mr. Zyskind was unavailable, it is not appropriate to accept the declaration at this time.

### **CONCLUSION**

For the reasons above, applicant's petition under 37 CFR 1.137(b) is **GRANTED**.

Applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

\$1370.00 will be deducted from Deposit Account No. 12-2325 (1240.00 petition fee for petition under 37 CFR 1.137(b) and \$130.00 for petition under 37 CFR 1.47(a)).

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. A proper reply under the renewed petition would be either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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